

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Robert J. Davidson**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/760,242**
Filed: **1/12/2001**
For: **PERSONAL MOVIE STORAGE MODULE**

Group Art: **2424**
Examiner: **James R. Sheleheda**

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF

This Brief is in furtherance of the Notice of Appeal and Pre-Appeal Brief Request for Review filed June 14, 2010.

This Brief contains these items under the following headings, and in the order set forth below:

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST

The real party in interest in this application is Seagate Technology LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals and there are no related interferences.

III. STATUS OF CLAIMS

The status of the claims in this proceeding is:

<u>CLAIM</u>	<u>STATUS</u>
1. (Previously presented)	Independent.
2. (Previously presented)	Depends from claim 1.
3. (Previously presented)	Depends from claim 2.
4. (Previously presented)	Depends from claim 1.
5. (Previously presented)	Depends from claim 37.
6. (Canceled)	
7. (Canceled)	
8. (Previously presented)	Depends from claim 1.
9. (Previously presented)	Independent.
10. (Canceled)	
11. (Previously presented)	Depends from claim 9.
12 (Original)	Depends from claim 11.
13. (Previously presented)	Depends from claim 11.
14. (Previously presented)	Depends from claim 13.
15. (Previously presented)	Depends from claim 9.
16. (Canceled)	
17. (Canceled)	
18. (Canceled)	
19. (Previously presented)	Depends from claim 1.
20. (Previously presented)	Depends from claim 1.
21. (Canceled)	
22. (Canceled)	
23. (Canceled)	
24. (Previously presented)	Depends from claim 1.
25. (Previously presented)	Depends from claim 24.
26. (Previously presented)	Depends from claim 1.
27. (Canceled)	
28. (Canceled)	
29. (Canceled)	
30. (Canceled)	
31. (Canceled)	
32. (Previously presented)	Depends from claim 1.
33. (Canceled)	
34. (Canceled)	
35. (Canceled)	
36. (Canceled)	
37. (Previously presented)	Depends from claim 1.
38. (Previously presented)	Depends from claim 26.

39. (Previously presented) Depends from claim 1.

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application: 1-39

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: 6, 7, 10, 16-18, 21-23, 27-31, 33-36
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-5, 8, 9, 11-15, 19, 20, 24-26, 32, and 37-39
4. Claims allowed: none
5. Claims rejected: 1-5, 8, 9, 11-15, 19, 20, 24-26, 32, and 37-39
6. Claims objected to: none

C. CLAIMS ON APPEAL

Claims now on appeal: 1-5, 8, 9, 11-15, 19, 20, 24-26, 32, and 37-39

IV. STATUS OF AMENDMENTS

Appellant filed a Pre-Brief Request on June 14, 2010. The Panel's Decision to proceed to appeal without comment is dated August 30, 2010.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention according to the language of claim 1 contemplate a method of portably handling entertainment media. The method includes storing in a memory of a portable digital storage module non-encoded entertainment media that is not encoded with any authorized usage condition (see specification page 5:14-18). After the storing step is completed, the method encodes the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media (see specification page 5:28-31).

Embodiments of the present invention according to the language of claims depending from claim 1 contemplate the storing step can include transferring a copy of the non-encoded entertainment media from a purchase center into the memory of the portable digital storage module (see specification page 5:10-11). The storing step can also include downloading the non-encoded entertainment media from a remotely located database (see specification page 5:5). The storing step can include storing two or more non-encoded entertainment media into the memory of the portable digital storage module (see specification page 6:3-6). The method can include retrieving the entertainment media by a digital format player device such as a notebook computer, a personal movie player, and a seatback-mounted movie viewer (see specification page 13:19-21). The storing step can be performed in a broadband frequency format (see specification page 4:22-23). The encoding step can be characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media a finite number of times and/or within a finite period of time (see specification page 5:30-31). The storing step can be characterized by the non-encoded entertainment media comprising audio data and/or video data (see specification page 4:13-16). The encoding step can be characterized by a predetermined association between a user-selected purchase price for the stored non-encoded entertainment media and the corresponding prescribed authorized usage (see specification page 5:31 to page 6:2). The encoding step can be characterized by automatically deleting the stored non-encoded entertainment media from the memory according to the prescribed authorized usage (see specification page 6:6-9).

The method can further include retrieving the stored non-encoded entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions (see specification page 5:28-31). The user-selected purchase price can be determined by a user's input to a point of purchase system, wherein the stored non-encoded entertainment media resides in the memory of the digital

storage module prior to the user's input (see specification page 5:16-18). After a request for a usage of the stored non-encoded entertainment media, the method can include changing the encoded access instructions and thereby changing the prescribed authorized usage condition of the stored non-encoded entertainment media in relation to the request for a usage of the stored non-encoded entertainment media (see specification page 5:3-5).

Embodiments of the present invention according to the language of claim 9 contemplate a portable digital storage module (such as 10) having an enclosure that is removably engageable with each of the plurality of digital devices (see specification page 6:17-20). The portable digital storage module has a memory (such as 50) in the enclosure, and an interface (such as 55) configured to operably communicate with a first digital device of the plurality of digital devices to store to the memory non-encoded entertainment media that is not encoded with any usage condition. A controller (such as 56) in the enclosure is configured to respond to access instructions that are encoded to the digital storage module via the interface after the non-encoded entertainment media has been stored to the memory to enable the interface to operably communicate with a second digital device of the plurality of digital devices to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.

Embodiments of the present invention according to the language of claims depending from claim 9 contemplate the memory can be an atomic resolution storage device (such as 100) having a field emitter (such as 102, 104) fabricated by semiconductor microfabrication techniques capable of generating an electron beam current. A storage medium (such as 106) is in proximity to the field emitter, having a storage area in one of a plurality of states to represent the information stored in the storage area (such as 108). An effect can be generated when the electron beam current bombards the storage area, wherein the magnitude of the effect depends upon the state of the storage area, and wherein the information stored in a storage area is read by measuring the magnitude of the effect (see specification page 11:6-8). A plurality of storage

areas can be provided on the storage medium, each storage area in one of a plurality of states to represent information stored in the storage area (see specification page 11:31 to page 12:22). A microfabricated mover (such as 110) in the storage device can position different storage areas to be bombarded by the electron beam current.

A plurality of field emitters can be provided, each emitter being fabricated by semiconductor microfabrication techniques capable of generating an electron beam current, the plurality of field emitters being spaced apart, with each emitter being responsible for a number of storage areas on the storage medium (see specification page 3:31 to page 4:2). Two or more of the plurality of the field emitters work in parallel to increase the data rate of the storage device (see specification page 9:21-23). Preferably, the memory is configured for subsequently storing data where different data was previously stored (see specification page 6:6-11).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-5, 8, 19, 20, 24, 25, 32, 37, and 39 stand rejected under 35 USC §103 as allegedly being unpatentable over Chung (US 6,628,963) in view of Kawakami (US 7,266,202).

Claims 9 and 15 stand rejected under 35 USC §103 as allegedly being unpatentable over Chung in view of Katayama (US 6,651,212) and Kawakami.

Claims 11-14 stand rejected under 35 USC §103 as allegedly being unpatentable over Chung, Katayama, and Kawakami in view of Gibson (US 5,557,596).

Claims 26 and 38 stand rejected under 35 USC §103 as allegedly being unpatentable over Chung and Kawakami and in view of Downs (US 6,226,618).

VII. ARGUMENT

Patentability of Claim 1

1. The cited references do not teach or suggest all the features of claim 1.

Claim 1 features in pertinent part:

storing...non-encoded entertainment media that is not encoded with any authorized usage condition... and after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media....¹

The language of claim 1 explicitly defines the featured *non-encoded entertainment media* to mean that it *is not encoded with any authorized usage condition*. Support for the featured *storing...non-encoded entertainment media that is not encoded with any authorized usage condition* is found at least in the disclosure that it can be advantageous to pre-record the non-encoded entertainment media to a portable storage module because of the time it takes to make such a recording. Pre-recording the non-encoded entertainment media allows a significantly faster sales transaction at the purchase center for the consumer who is likely on the go:

Since download times take more than a few minutes, purchase center 12 can offer personal movie storage modules 10 for sale that already have a movie stored on the module 10.²

However, the disclosure also speaks to the fact that pre-recording the entertainment media to include also pre-recording usage conditions is problematic because the usage conditions will vary from consumer to consumer. That is, it is advantageous to permit the consumer to make choices such as to how long or as to how many viewings of the entertainment media she would like to purchase. Normally, a longer viewing time or more viewings can be had for the payment of a premium. Thus, claim 1 also features encoding the portable digital storage module with a usage condition after the non-encoded entertainment media has been stored to it (such as pre-recorded), in terms of *after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.*

¹ Excerpt of claim 1 (emphasis added).

² Specification pg. 5:16-18.

Importantly, Appellant has shown that claim 1 plainly features the result of the encoding step being that the portable digital storage module contains access instructions that, by the explicit meaning stemming from antecedent basis reference, exist in the portable module and at the same time define a prescribed authorized usage condition of the stored non-encoded entertainment media.³ The plain meaning of claim 1 is that the encoding step writes the access instructions to the module but not to the already stored non-encoded entertainment media. The Office's rationale for the rejection is that neither the claim language nor the specification require the non-encoded entertainment media to remain non-encoded entertainment media after the encoding step.⁴ For the reasons below, Appellant previously showed that the Office's rationale both fails to reasonably construe the claim language and mischaracterizes the prior art, leaving unresolved factual issues that should have been addressed before requiring Appellant to go to appeal.⁵

Support for the featured encoding step writing the access instructions to the module, not to the already stored non-encoded entertainment media, is found at least in the controller 56 intelligence residing in the module 10:

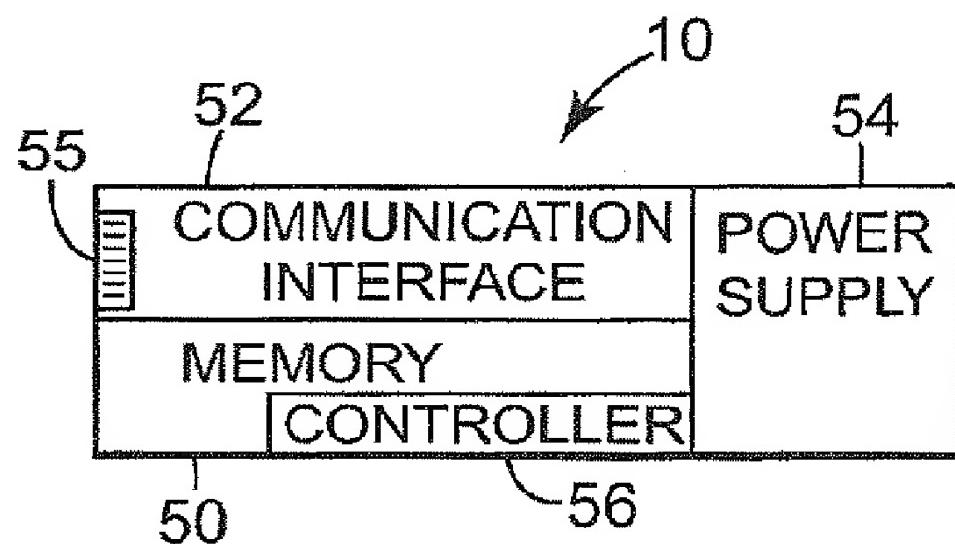


Fig. 3

³ Applicant's Pre-Brief Request of 6/14/2010 ppg. 1-3; Applicant's Response of 4/5/2010 pg. 8.

⁴ Office Action of 4/13/2010 pg. 2.

⁵ Applicant's Pre-Brief Request ppg. 1-3.

The controller 56 is disclosed as being capable of top level operational control of the portable module 10, to include controlling access by a playback device to data stored in the memory 50 (where the non-encoded entertainment media is stored) via the communication interface 52.⁶ The skilled artisan having read the specification readily understands how the featured *encoding the portable digital storage module* is achieved by writing access instructions to the memory 50, not necessarily the already *stored non-encoded entertainment media*, that are executable by the controller 56 to restrict access by a playback device to the *stored non-encoded entertainment media*:

During purchase of the movie, purchase center 12 encodes personal movie storage module 10 with instructions to either allow unlimited viewing of the movie, or to limit viewing to a finite number of viewing or to a finite period of time (e.g. 24 hours).⁷

Appellant and the Office agree that Chung does not teach or suggest at least the encoding feature of claim 1. However, Appellant respectfully traverses the Office's rationale that Kawakami allegedly cures the deficiency of Chung in this regard.

The Office's rationale is generally that Kawakami allegedly teaches or suggests transferring non-encoded digital content to a portable device and then encoding the device with usage conditions. However, Applicant has shown in the record that Kawakami only discloses storing encoded content to the portable devices; the encoded content being encoded with usage condition information.⁸ For example, Applicant has shown that Kawakami explicitly discloses the data transferred to the portable device is in the form of a packet composed of a header and a content, the header defining the usage condition information:

A data to be transferred to the portable device 6 is composed of a header and content. The header stores a

⁶ Original claim 7: "a controller logic for operating the storage device and communicating between the memory component and the communication interface"; original claim 10; specification pg. 6:22-23: "controller 56 for facilitating control of module 10 and/or of other devices used in association with module 10."; specification pg. 14:24-26: "In use, module 10 is placed in slot 236 to permit a controller and communication interface (not shown) in personal playback device 230 to display the movie on video display 232...."

⁷ Specification pg. 5:28-31 (emphasis added).

⁸ Applicant's Pre-Brief Request ppg. 3-5; Applicant's Response of 4/5/2010 ppg. 8-9, note 3.

content ID, file name, header size, content key, file size, codec ID, file information, etc. and also a playback limitation data, start date, end date, playback limit, playback counter, etc., necessary for the playback limitation.⁹

The Office's rationale that Kawakami allegedly teaches the *storing...non-encoded entertainment media* feature includes the following:

In an analogous art, Kawakami discloses a content delivery system (Fig. 1) wherein non-encoded digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55). . . .¹⁰

This passage the Office relies on describes aspects of Kawakami's content management system. However, neither that cited passage nor any other passage of Kawakami refutes Appellant's showing that Kawakami, considered as a whole, only discloses that data is transferred to a portable device in the form of a packet that accompanies the content with a header containing the usage conditions. Appellant has pointed out that the Office's rationale is erroneous as a misplaced characterization of Kawakami because the Office narrowly relies only on Kawakami's content management disclosure to the exclusion of Kawakami's disclosure of how the content is transferred to a portable device. Appellant also identified the Office's misplaced characterization of Kawakami as an unresolved factual issue that should have been addressed before requiring Appellant to go to appeal.¹¹

The Office's rationale for the rejection also points to Kawakami's disclosure in FIG. 19:

In response, to applicant's arguments on pages 8-9 regarding Kawakami, it is noted that Kawakami discloses two separate pieces of information, the content and the usage data. As seen in Fig. 4, they are separately stored and processed pieces of data (content file 161-1 and usage rule file, 162-1). As seen in Fig. 19, the content is transmitted to the portable device first (S119-S120). After the content is stored in the portable device, the usage rules are then converted to the proper format and transmitted to the portable device (S121-124). Thus, Kawakami clearly discloses storing the entertainment media without

⁹ Kawakami col. 10:32-37 (emphasis added).

¹⁰ Office Action of 4/13/2010 pg. 4 (emphasis added).

¹¹ Applicant's Pre-Brief Request of 6/14/2010 pg. 3; Applicant's Response of 4/5/2010 pg. 9.

“encoding” it with the usage conditions, as it is explicitly disclosed as being a separate data file which is downloaded to the portable device prior to the usage conditions.¹²

The entirety of Kawakami’s disclosure regarding FIG. 19 is on the face of FIG. 19 itself, because neither FIG. 19 nor any of its constituent blocks S119-S126 are substantively discussed or even referred to; FIG. 19 is merely mentioned in Kawakami’s brief description of the drawings section. The Office’s stated interpretation is that blocks S119 and S120 allegedly disclose the content alone being stored to the portable device. However, the skilled artisan having read Kawakami recognizes the Office’s interpretation is misplaced because block S120 discloses the portable device will store the music data already transferred. Kawakami discloses the music data is the usage condition information, such as but not limited to that depicted in the music data base in FIG. 11 and the descriptions thereof.¹³ The skilled artisan reasonably understands from the disclosure of FIG. 19 that because the music data is already transferred in block S120, that means the music data must have been previously transferred either before or with the content in block S119. There is nothing in Kawakami that would lead the skilled artisan to believe that block S119 transfers only the content. The interpretation that the music data is transferred with the content is consistent with the entirety of Kawakami’s disclosure, including but not limited to the passage of Kawakami cited above that generally defines the transferred data being packetized to include the header (containing the usage condition information) with the associated content.¹⁴

The Office’s rationale that Kawakami allegedly teaches the featured *after the storing...encoding* feature of claim 1 is the following:

Kawakami discloses...a programmable controller is programmed with access instructions corresponding to a

¹² Office Action of 4/13/2010 pg. 3 (emphasis added).

¹³ FIG. 11 discloses the music data base includes usage condition information such as PLAYBACK CONDITION: START DATE; PLAYBACK CONDITION: END DATE; PLAYBACK CONDITION: PLAYBACK LIMIT; PLAYBACK COUNTER; PLAYBACK ACCOUNTING CONDITION; COPYING CONDITION: COPIES; COPY COUNTER; COPYING CONDITION: SCMS.

¹⁴ Note 7.

predefined limit of authorized playing of the entertainment media are (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55)....¹⁵

These cited passages are consistent with Kawakami's disclosure as a whole that it transfers data to a portable device in a packet including both the header and the content. For example, included in these cited passages is the following excerpt of Kawakami:

The portable device 6-1 stores the content supplied from the personal computer 1 (i.e., a checked-out content) along with data related with the content (e.g., title or playback limit of each music piece).¹⁶

These passages the Office relies on also disclose the data (header and content) being stored to a portable device, and played back under the control of the CPU 53. However, the skilled artisan having read Kawakami understands that the only usage instructions the CPU 53 receives are those in the encoded content of data transfers. For example:

A USB controller 57 is provided in the portable device 6. When connected to the personal computer 1 by a USB connector 56 and USB cable 7, the USB controller 57 will supply data including a content transferred from the personal computer 1 to the CPU 53 via an internal bus 58.¹⁷

As discussed above, the "data including a content" refers to the data as having been defined as the header and the content (encoded content), the header providing the usage condition. None of the passages cited by the Office, or any other passages, teach or suggest anything contrary to the fact that Kawakami supplies the already encoded content to the CPU 53. Accordingly, the skilled artisan having read Kawakami understands that it does not teach or suggest the *after the storing...encoding* feature of claim 1.

The Office has failed to substantiate any evidence that rebuts Applicant's showing that Kawakami always transfers data to a portable device in the form of a packet including a header containing usage conditions with the content. The Office's various interests in discussing

¹⁵ Office Action pg. 3.

¹⁶ Kawakami col. 8:11-14 (emphasis added).

¹⁷ Kawakami col. 10:23-27 (emphasis added).

Kawakami's content management disclosure is at best irrelevant to the claimed subject matter, and at worst used to mischaracterize what Kawakami actually discloses as a whole. The Office has not substantiated *prima facie* obviousness by not showing that the art of record at least teaches or suggests *storing...non-encoded entertainment media... and after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media* as featured by claim 1. In fact, the *storing...non-encoded entertainment media* language of rejected claim 1 **specifically excludes** what Chung and Kawakami teach or suggest. The Office's claim construction is reversible error because it does, in effect, ignore claim language and hence ignore the invention as claimed.¹⁸

KSR left untouched the requirement that a teaching for each claim limitation must be shown in the prior art in order to substantiate a *prima facie* case of obviousness.¹⁹ For the reasons above, the Office has failed to substantiate evidence that the cited references, alone or combined, teach or suggest at least the *storing...non-encoded entertainment media... and after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media* feature of claim 1.

2. The Office has not shown that the missing feature is merely obvious.

In the absence of evidence that the cited references teach all the features of the rejected claims, the Office is then obligated to bridge that gap in the teachings of the cited references to articulate sound reasoning as to why the skilled artisan would find the differences between the claimed subject matter and what the cited references teach to be merely obvious, not rising to the

¹⁸ See 37 CFR 1.104(a)(1).

¹⁹ *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); MPEP 2143.03; MPEP 2141.

level of patentability.

For the reasons stated above, Appellant has shown that the Office has not shown that the cited references teach or suggest at least the *storing...non-encoded entertainment media...* and *after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media* feature of claim 1. The Office has not acknowledged that omission, and as such has made no such showing to bridge the gap in the teachings.

The Office has an obligation to meet the *Graham*²⁰ requirement of properly ascertaining the difference between the claimed subject matter and the prior art. As discussed above, the Office's rejection is reversible error at least for the reason that the Office relies on a misplaced characterization of Kawakami that it allegedly teaches or suggests transferring content without header information to a portable device. The evidence in the record is determinative that the Office has not shown that the cited references, even as modified within the knowledge of the skilled artisan, teach or suggest at least the *storing...non-encoded entertainment media...* and *after the storing step...encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media* feature of claim 1.

3. Hindsight reconstruction.

The Office's rationale for the rejection winds up exceeding the bounds of what the skilled artisan would agree the prior art to teach. Guided by *KSR* in determining obviousness, the only reasonable conclusion is that the Office's stated rationale is lacking the requisite rational underpinning to support any legal conclusion of obviousness. Lacking the requisite legal reasoning, the Office's rejection fails to pass muster under *Graham* because ultimately it has the

²⁰ *Graham v. John Deere*, 383 US 1 (1966).

effect of being based entirely upon an impermissible hindsight reconstruction of the claimed embodiments. Given the subtle but powerful attraction of a hindsight-based obviousness analysis, a rigorous application of the requirement of an evidentiary basis for the rejection must be followed.

Accordingly, the Office has not made out a *prima facie* case of obviousness by not showing that the prior art, even as modified by the skilled artisan, teaches or suggests all the features of rejected claim 1. Appellant therefore respectfully requests that the Board reverse the rejection of claim 1 and the claims depending therefrom.

Patentability of Claim 9

Claim 9 recites an apparatus mirroring the subject matter of claim 1 discussed above, in terms of *a controller...to respond to access instructions that are encoded to the digital storage module...after the non-encoded entertainment media has been stored to the memory...to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.* The Office's rationale for the rejection of claim 9 is the same as for claim 1 with regard to Chung and Kawakami. The Office further relies on Katayama for its disclosure of a controller. However, Appellant has shown that Katayama does not teach or suggest encoding access instructions at all,²¹ and as such does not cure the deficiency of Chung and Kawakami regarding at least the feature of claim 9 excerpted above for the reasons set forth for claim 1. Thus, the Office has not made out a *prima facie* case of obviousness by not showing that the prior art, even as modified by the skilled artisan, teaches or suggests all the features of rejected claim 9. Appellant therefore respectfully requests that the Board reverse the rejection of claim 9 and the claims depending therefrom.

²¹ Applicant's Response of 4/5/2010 pg. 16.

Patentability of Claim 2

Claim 2 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 2 further features *the storing step further comprises transferring a copy of the non-encoded entertainment media from a purchase center into the memory to the portable digital storage module*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 2.

Patentability of Claim 3

Claim 3 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 3 further features *the storing step further comprises downloading the non-encoded entertainment media from a remotely located database*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 3.

Patentability of Claim 4

Claim 4 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 4 further features *the storing step further comprises storing two or more non-encoded entertainment media into the memory of the portable digital storage module*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 4.

Patentability of Claim 5

Claim 5 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 5 further features *the retrieving step is characterized by the digital format player device including at least one of a notebook computer, a personal movie player, and a seatback-mounted movie viewer*. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 5.

Patentability of Claim 8

Claim 8 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 8 further features *the*

storing step is performed in a broadband frequency format. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office’s Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 8.

Patentability of Claims 11-14

Claims 11-14 are allowable at least because they depend from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claims 11-14 further feature the memory being characterized as an atomic resolution storage device. The Office has not substantiated any evidence as to why the skilled artisan, having read the cited references, would be motivated to modify Chung, Katayama, and Kawakami to include Gibson’s structure. The Office’s stated rationale “for the typical benefit of taking advantage of the benefits...” is conclusory, not rising to the requisite rationale underpinning substantiating a legal conclusion of obviousness. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office’s Answer. Appellant respectfully requests that the Board withdraw the rejection of claims 11-14.

Patentability of Claim 15

Claim 15 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and each recites an additional feature. Particularly, claim 15 further features *the memory is configured for subsequently storing data where different data was*

previously stored. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 15.

Patentability of Claim 19

Claim 19 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 19 further features *the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media a finite number of times.* Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 19.

Patentability of Claim 20

Claim 20 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 20 further features *the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media within a finite period of time.* Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the

right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 20.

Patentability of Claim 24

Claim 24 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 24 further features *the storing step is characterized by the non-encoded entertainment media comprising audio data*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 24.

Patentability of Claim 25

Claim 25 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 25 further features *the storing step is characterized by the non-encoded entertainment media comprising video data*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary

considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 25.

Patentability of Claim 26

Claim 26 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 26 further features *the encoding step is characterized by a predetermined association between a user-selected purchase price for the stored non-encoded entertainment media and the corresponding prescribed authorized usage*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Downs fails to cure the deficiency of Chung and Kawakami in that regard. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 26.

Patentability of Claim 32

Claim 32 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 32 further features *the encoding step is characterized by automatically deleting the stored non-encoded entertainment media from the memory according to the prescribed authorized usage*. Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like

in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 32.

Patentability of Claim 37

Claim 37 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 37 further features *retrieving the stored non-encoded entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instruction.* Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office's Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 37.

Patentability of Claim 38

Claim 38 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 38 further features *the user-selected purchase price being determined by a user's input to a point of purchase system, wherein the stored non-encoded entertainment media resides in the memory of the digital storage module prior to the user's input.* Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. Downs fails to cure the deficiency of Chung and Kawakami in that regard. This claim language more particularly points out and distinctly claims the fact that non-encoded entertainment media resides in the claimed invention, which is distinguishable over what Kawakami teaches or suggests. Further, in the present

absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office’s Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 38.

Patentability of Claim 39

Claim 39 is allowable at least because it depends from an allowable independent claim, for reasons stated above, and recites an additional feature. Particularly, claim 39 further features *after a request for a usage of the stored non-encoded entertainment media, changing the encoded access instructions and thereby changing the prescribed authorized usage condition of the stored non-encoded entertainment media in relation to the request for a usage of the stored non-encoded entertainment media.* Kawakami teaches the opposite, in that it only transfers encoded entertainment media to the portable device. This language more particularly points out and distinctly claims the fact that non-encoded entertainment media resides in the claimed invention, which is distinguishable over what Kawakami teaches or suggests. Further, in the present absence of a *prima facie* case, Appellant reserves the right to further show evidence of nonobviousness in terms of lack of motivation to the skilled artisan to modify and/or combine the references to arrive at the claimed invention, secondary considerations, and the like in response to new evidence in the Office’s Answer. Appellant respectfully requests that the Board withdraw the rejection of claim 39.

Conclusion

For the reasons above, Appellant respectfully requests that the Board reverse the final rejection of claims 1 and 9 and the claims depending therefrom.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. (Previously presented) A method of portably handling entertainment media comprising:
 - storing in a memory of a portable digital storage module non-encoded entertainment media that is not encoded with any authorized usage condition; and
 - after the storing step is completed, encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.
2. (Previously presented) The method of claim 1, wherein the storing step further comprises transferring a copy of the non-encoded entertainment media from a purchase center into the memory of the portable digital storage module.
3. (Previously presented) The method of claim 2, wherein the storing step further comprises downloading the non-encoded entertainment media from a remotely located database.
4. (Previously presented) The method of claim 1 wherein the storing step further comprises storing two or more non-encoded entertainment media into the memory of the portable digital storage module.
5. (Previously presented) The method of claim 37 wherein the retrieving step is characterized by the digital format player device including at least one of a notebook computer, a personal movie player, and a seatback-mounted movie viewer.
6. – 7. (Canceled)

8. (Previously presented) The method of claim 1 wherein the storing step is performed in a broadband frequency format.

9. (Previously presented) A portable digital storage module comprising:
an enclosure that is removably engageable with each of a plurality of digital devices;
a memory in the enclosure;
an interface configured to operably communicate with a first digital device of the plurality of digital devices to store to the memory non-encoded entertainment media that is not encoded with any usage condition; and
a controller in the enclosure configured to respond to access instructions that are encoded to the digital storage module via the interface after the non-encoded entertainment media has been stored to the memory to enable the interface to operably communicate with a second digital device of the plurality of digital devices to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.

10. (Canceled)

11. (Previously presented) The module of claim 9 wherein the memory is characterized as an atomic resolution storage device comprising:

a field emitter fabricated by semiconductor microfabrication techniques capable of generating an electron beam current; and

a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area.

12. (Original) The module of claim 11, wherein an effect is generated when the electron beam current bombards the storage area, wherein the magnitude of the effect depends upon the state of the storage area, and wherein the information stored in a storage area is read by measuring the magnitude of the effect.

13. (Previously presented) The module of claim 11, and further comprising:

a plurality of storage areas on the storage medium, each storage area in one of a plurality of states to represent information stored in the storage area; and

a microfabricated mover in the storage device to position different storage areas to be bombarded by the electron beam current.

14. (Previously presented) The module of claim 13, and further comprising:

a plurality of field emitters, each emitter fabricated by semiconductor microfabrication techniques capable of generating an electron beam current, the plurality of field emitters being spaced apart, with each emitter being responsible for a number of storage areas on the storage medium; and

such that a plurality of the field emitters work in parallel to increase the data rate of the storage device.

15. (Previously presented) The module of claim 9 wherein the memory is configured for subsequently storing data where different data was previously stored.

16. – 18. (Canceled)

19. (Previously presented) The method of claim 1 wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media a finite number of times.

20. (Previously presented) The method of claim 1 wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media within a finite period of time.

21. – 23. (Canceled)

24. (Previously presented) The method of claim 1 wherein the storing step is characterized by the non-encoded entertainment media comprising audio data.

25. (Previously presented) The method of claim 24 wherein the storing step is characterized by the non-encoded entertainment media comprising video data.

26. (Previously presented) The method of claim 1 wherein the encoding step is characterized by a predetermined association between a user-selected purchase price for the stored non-encoded entertainment media and the corresponding prescribed authorized usage.

27. - 31. (Canceled)

32. (Previously presented) The method of claim 1 wherein the encoding step is characterized by automatically deleting the stored non-encoded entertainment media from the memory according to the prescribed authorized usage.

33. – 36. (Canceled)

37. (Previously presented) The method of claim 1 further comprising retrieving the stored non-encoded entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions.

38. (Previously presented) The method of claim 26 characterized by the user-selected purchase price being determined by a user's input to a point of purchase system, wherein the stored non-encoded entertainment media resides in the memory of the digital storage module prior to the user's input.

39. (Previously presented) The method of claim 1, further comprising after a request for a usage of the stored non-encoded entertainment media, changing the encoded access instructions and thereby changing the prescribed authorized usage condition of the stored non-encoded entertainment media in relation to the request for a usage of the stored non-encoded entertainment media

IX. EVIDENCE APPENDIX

No additional evidence is included.

X. RELATED PROCEEDINGS APPENDIX

There exist no relevant related proceedings concerning this Appeal before the Board.